

### **REMARKS**

Claims 1–30 are pending. By this Amendment, claims 1 and 11 are amended. Reconsideration of the present application is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Weeks in the February 1, 2008 telephone conference. Applicant's separate record of the substance of the interview is incorporated into the following remarks. Specifically, claims 1 and 11 are amended to comply with the Examiner's helpful suggestions made during the interview.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any applied references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the applied references. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

#### **A. The Claims Satisfy the Requirements of 35 U.S.C. §112**

The Office action rejects claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office action objects to the phrase "the tablet compartment" in line 16 (lines 14–15 of the present amendment) for having insufficient antecedent basis. This rejection is respectfully traversed.

It is respectfully asserted that "allocating a tablet compartment of a tablet container" as recited in line 12 of claim 11 provides sufficient antecedent basis for "the tablet compartment of the respective tablet container." As indicated in our February 1, 2008 telephone interview with

Examiner Weeks, there is proper antecedent basis for "the tablet compartment." Accordingly, withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

On a separate issue, Examiner Weeks pointed out that there may be a translation error in the phrase "the tablets thus determined are filled," as recite in claim 1 and the phrase "the automatic tablet dispenser is designed for filling the tablets," as recited in claim 11. Applicant has amended these phrases in accordance with the Examiner's helpful suggestions.

**B. The Claims Define Allowable Subject Matter**

The Office Action rejects claims 1–21 and 24–30 under 35 U.S.C. § 102(e)<sup>1</sup> over U.S. Patent No. 7,010,899 to McErlean et al., and claims 1, 2, 11, 12, 22 and 23 under 35 U.S.C. § 102(b) over U.S. Patent No. 6,449,921 to Kim. Because McErlean and Kim do not teach each and every element of the rejected claims, Applicant respectfully traverses this rejection in view of the following remarks.

The applied references fail to teach a method, "wherein the number of tablets of the respective types of tablets to be taken by a patient at certain times is determined from the prescription data and a tablet compartment of a tablet container is allocated to each determined time for taking the tablets and the tablets thus determined are filled in the tablet container for each determined time for taking them into the respective tablet compartment that has been allocated," as recited in claim 1, and a system, "wherein the allocation means or the automatic tablet dispenser is/are designed for determining, from the prescription data, the number of tablets of the respective types of tablets to be taken by a patient at certain times and for allocating a tablet compartment of a tablet container to each determined time for taking the tablets, and the automatic tablet dispenser is designed for filling the tablet container with the tablets thus

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<sup>1</sup> McErlean is only citable under 35 U.S.C. § 102(e). Applicant does not admit that McErlean is in fact prior art to the claimed invention but reserve the right to swear behind McErlean if necessary to remove it as a reference.

determined for each determined time for taking them into the tablet compartment of the respective tablet container, which compartment has been allocated," as recited in claim 11.

Applicant has found no indication in the applied references of these features recited in claims 1 and 11. Moreover, the Office action fails to point out where these are taught in the references. As such, Applicant submits that the Office action has failed to set forth a *prima facie* case for the rejections and respectfully request that the rejection be withdrawn.

Applicant asserts that a method, wherein the number of tablets of the respective types of tablets to be taken by a patient at certain times is determined from the prescription data and a tablet compartment of a tablet container is allocated to each determined time for taking the tablets and the tablets thus determined are filled in the tablet container for each determined time for taking them into the respective tablet compartment that has been allocated is neither disclosed in McErlean nor Kim. Likewise, a system, wherein the allocation means or the automatic tablet dispenser is/are designed for determining, from the prescription data, the number of tablets of the respective types of tablets to be taken by a patient at certain times and for allocating a tablet compartment of a tablet container to each determined time for taking the tablets, and the automatic tablet dispenser is designed for filling the tablet container with the tablets thus determined for each determined time for taking them into the tablet compartment of the respective tablet container, which compartment has been allocated is not disclosed in McErlean or Kim.

Accordingly, Applicant respectfully asserts that the rejections under 35 U.S.C. §102 should be withdrawn because the applied references, either individually or in combination, do not teach each feature of independent claims 1 and 11.

As pointed out in MPEP §2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

For at least these reasons, it is respectfully submitted that independent claims 1 and 11 are patentable over the applied references. The remainder of the claims that depend from independent claims 1 and 11 are likewise patentable over the applied references for at least the reasons discussed above, as well as for the additional features they recite.

### **C. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1–30 are earnestly solicited.

Should the Examiner find any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 4<sup>th</sup> day of February 2008.

Respectfully submitted,

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